

REMARKS

Claims 1, 2, and 4-7 remain in the application.

The Office Action rejects claims 1, 2, 4, 5, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Parthesarathy *et al.* (US6353926B1) in view of Lloyd *et al.* (US6779178B1).

As a preliminary matter, the Applicant asks that the Examiner indicate the statutory basis for citing Lloyd *et al* as prior art since the date of publication, August 17 2004, is well after the Applicant's priority date of November 2000.

Regarding claim 1, according to the Office Action, Parthesarathy discloses a method of updating computer and/or data in a recipient computer as claimed except that Parthesarathy doesn't explicitly disclose the software and/or data update comprising an email message having one or more files to be updated sent as attachment files in the email message. However, according to the Action, Parthesarathy does disclose communicating information to the user regarding updates via email and Lloyd discloses the delivery of customized software as an e-mail attachment, so it would have been obvious to combine the two references because "it would have enabled installing software automatically using an installation electronic mail client."

The Applicant initiated a telephone interview 24 February 2005 to discern which prior art passages the Examiner considers to disclose certain claimed features of the invention. The Applicant requests reconsideration because the Applicant had sought this information in the Applicant's responses to the past two office actions and received no explanation.

One question that the Applicant asked the Examiner during this telephone interview was, "where does Parthesarathy disclose the subsequent preparation of a software and/or data update in response to receiving and analyzing such a request?" In response to this question the Examiner stated that nothing in claim 1 excludes the "owner" from being a "client" and that there was confusion over claim terminology regarding what an owner computer is and what a client computer is. The Examiner had interpreted "owner computer" as reading on a client computer. In response, the Applicant has redrafted the beginning of claim 1 to make this more explicit. The Applicant has also amended claim 1 to include a limitation requiring that the update request specify the files to be updated. This feature is directly derivable from current claim 2 and does not introduce any new, previously unsearched, features to the claims.

Another question that the Applicant asked the Examiner during the telephone interview was, "where does Parthesarathy disclose the use of email to send an update REQUEST as opposed to notification?" Citing the paragraph beginning at column 4, line 39 of Parthesarathy the Examiner responded by arguing that because a client computer in a client/server computer system is known to "request" services from the server, and because it is known for a client or server within a client/server system to also perform each of those functions from time to time, it follows that the e-mail notification sent from the vendor's computer in Parthesarathy anticipates the update request sent by the recipient computer as recited in our claim 1.

In response, the Applicant again notes that, as recited in claim 1, it is the recipient computer i.e. the computer that is to be updated (analogous to the user's computer in Parthesarathy), that sends the update request in the form of an e-mail message. Even if we are to accept the Examiner's argument that the e-mail notification of the availability of an update that is sent in Parthesarathy by the vendor computer to the user's computer constitutes an update request, it still cannot be said to be sent from, or by, the computer that is to be updated, i.e. the recipient computer, as claimed. In contrast, the computer in

Parthesarathy sending this "request" is the computer that is providing the updates, i.e. the "data owner" computer in the language of amended claim 1. Likewise, while the checking that is performed by the user's computer in Parthesarathy to determine if an update is available (column 6, line 4-6) might be seen to constitute "analyzing", the Applicant argues that:

1) it is the data owner computer i.e. the computer that provides the software updates, and not the user's computer that performs the analyzing;

2) the analysis is done on the update request itself to determine the files that are to be updated (as opposed to simply determining if an update is available or not); and

3) the analysis occurs in response to receiving the update request e-mail. In column 6, lines 1 to 31 of Parthesarathy please note that the checking that is performed is done before the user is notified that an update is available. If the Examiner considers the e-mail notification to constitute the update request recited in claim 1, then the analysis of the update request that the Applicant claims cannot be anticipated by the checking steps disclosed in Parthesarathy that occur before the "update request" is sent by the vendor computer.

The applicant further maintains that the office action doesn't present a *prima facie* case for obviousness. It's well settled that, to support an obviousness determination based on a combination of prior art references, you must show why a skilled person, *confronted with the same problems as the inventor* and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). To help reduce the likelihood of improper hindsight-type analyses in these situations, the courts have held that an examiner, to support such an obviousness finding, must show evidence of a motivation to combine the references that create the case of obviousness. See, e.g., *In re Rouffet* at 1457-1458.

Evidence of motivation to combine may come in the form of an express teaching or suggestion in the prior art or in knowledge generally available to one of ordinary skill in the art. *See, e.g., In re Oetiker*, 24 USPQ2d 1443, 1446-1447 (Fed. Cir. 1992). Evidence of motivation may also be found in “the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.* 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *See also, e.g., In re Rinehart*, 189 USPQ 143, 149 (CCPA 1976); *In re Rouffet* at 1458; *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.* 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)(the prior art teaching must solve the same problem as the applicant sought to solve through the invention); *In re Oetiker* at 1446-1447. In other words, if an examiner is unable to find evidence of motivation in an express teaching or suggestion in the prior art or knowledge generally available to one of ordinary skill in the art, the examiner can still show an implicit motivation to combine with evidence that one skilled in the art, confronted with the same problem as the inventor, would know to use a prior art teaching to solve that problem, i.e., the problem that the applicant sought to solve through the invention in question. *Id.* For this to be the case, the problem that the invention solves must be the same as or at least similar to the problem that the prior art teaching solves. *In re Rinehart* at 149; *Para-Ordinance* at 1240; *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997) (“the record evidence supports the jury’s implicit finding of a suggestion to combine the various references . . .[which] were related and involved similar problems and issues.”); *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) (“to say that the missing step comes from the nature of the problem to be solved begs the question because the Board has failed to show that this problem had been previously identified anywhere in the prior art”). The rationale behind this test is that, unless the problem that the inventor solved by including the features in question in his invention is the same as or at least similar to the problem that the prior art solved through the use of those same features, there’s no reason to expect that one of ordinary skill in the art would associate the prior art features with the solution to the inventor’s problem.

For these reasons it's not enough to simply identify an advantage that the suggested combination would share with the claimed invention. If the combination reaches the invention, then it will *always* and *necessarily* provide the same advantages as the invention. To conclude that an invention is obvious because a combination of prior art references that produces the same invention would provide the same advantages, is no different from defining an obvious invention as being one that provides the same advantages as itself. Since this is true of all inventions, the existence of such a shared advantage is obviously incapable of distinguishing between obvious and non-obvious inventions.

To distinguish between obvious and non-obvious combinations one must instead produce evidence of a teaching or suggestion that would have motivated one skilled in the art to combine those particular references in such a way as to *realize* the advantage. To reason that the advantage of the combination can, itself, serve as the motivation to combine is, therefore, essentially tautological. It short-circuits the proper analysis and can be used to mischaracterize *any* inventive combination as being obvious. Under this test, it's only when an examiner finds identity (or at least similarity) between the *specific* problem that the inventor solved using the feature in question and a problem solved in a prior art reference using that same feature, that the examiner can fairly conclude that the invention is obvious, or, in other words, the pertinent motivation is a motivation to make obvious the technologic advance, not the omnipresent motivation to achieve a competitive advantage or achieve economic benefit.

Further regarding the question of motivation the Applicant notes that, in Parthesarathy *et al*, the two computers are directly connected to one another within a network environment, in this case via the Internet, and communicate with each other directly, presumably using the appropriate network and/or IP protocols. This is explicit in Parthesarathy in that the reference discusses the use of a "software update channel" and that the user's computer checks for available updates and the updates are automatically

downloaded from the vendor computer to the user computer without the use of additional separate communication means. In the method claimed in our current application, communication is explicitly performed using e-mail. As explained in the second sentence of the third paragraph of our application as filed, direct communication between two computers may not be possible due to a variety of restrictions including the presence of fire-walls, IP address translation and other possible restrictions. It is to avoid these restrictions that e-mail is used. Since e-mail is used there is no requirement for a direct connection between the two computers. The Applicant can find nothing in Parthesarathy that identifies this or a similar potential problem, or any other reasoning, that would provide appropriate motivation to a skilled person to provide the appropriate update requests and updates via e-mail, rather than by using the direct network connection that Parthesarathy teaches must exist between the two computers. In some respects, to use e-mail for the automatic updating of a computer may be considered counterintuitive since it requires the computers to make use of additional resources beyond the inherent background resources already available to them.

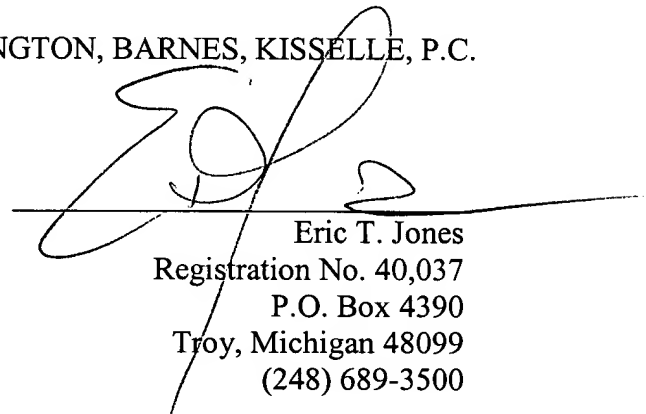
As a final note, the Applicant asks that, rather than focusing on the question of whether or not the actual provision of the software updates as an e-mail attachment as an isolated act is inventive or not, that the Examiner consider, instead, that the inventiveness of the claimed method is based on a combination of method elements with perhaps the emphasis being placed on the automatic use of e-mail for communication and the update request that instigates the procedure originating from the computer requiring the update. The overall inventiveness of the claim resides in a combination comprising contributions from each of the individual claim integers.

For all these reasons, the Applicant maintains that claim 1 is patentable over the cited references and that claims 2 and 4-7 are allowable because they depend from claim 1.

Claims 1, 2, and 4-7 recite patentable subject matter and are allowable. Therefore, the applicant respectfully submits that the application is now in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding office action.

Respectfully submitted,

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